

Attorney Docket No. P68040US1  
Application No. 10/674,824

**Remarks/Arguments:**

Claim 1, amended hereby, and claims 5 and 6, previously presented, are pending.

Claims 2-4 and 7 are canceled, without prejudice or disclaimer.

Claim 1 is amended, hereby, in order to

(i) limit the "isocyanate group-terminated urethane prepolymer"—component (a)—by specifying the "OH/NCO" ratio of the "polyisocyanate" reactant (as described at page 2, line 27, to page 3, line 2, of the instant specification) and the alternative (Markush group) "polyols" reactant (as described at page 3, 1<sup>st</sup> complete ¶, of the instant specification) used in its preparation and

(ii) incorporate into claim 1 the amounts of components (b), (c), and (d) recited in claims 4 and 7.

Claims 1 and 4-7 were rejected under 35 U.S.C. 112, second paragraph, as being allegedly indefinite. Reconsideration is requested.

According to the statement of rejection, the claims are allegedly indefinite because "components a) and b) are not mutually exclusive." Contrary to the allegation, there is no requirement that claim limitations be mutually exclusive in order to satisfy the requirements of §112, ¶2. Nonetheless, in a good faith effort to advance prosecution, applicants have amended the claims to establish mutual exclusivity between the recited components a) and b).

It is clear from amended claim 1 that components (a) and (b) are mutually exclusive. The urethane prepolymer, i.e., component (a), is prepared by reacting polyols having a relatively high

Attorney Docket No. P68040US1  
Application No. 10/674,824

molecular weight with polyisocyanate compounds. On the other hand, the hexamethylene diisocyanate derivative, i.e., component (b), has a relatively low molecular weight.

Claims 1 and 4-7 were rejected under 35 USC 103(a) as being allegedly unpatentable over JP 11263962 (JP'692) or US 6362300 (Araki), each taken in view of US 3627722 (Seiter), US 4857623 (Emmerling), and US 6875303 (Samurkas). Reconsideration is requested.

In the field of polyurethane adhesives, an extremely wide variety of components are described, and those skilled in the art must choose optimal components and determine the optimal proportion of the components to one another for a particular application field.

The prior art found it usually difficult to bond glass to painted steel using an adhesive without using any primer. Through intensive investigation the present inventors found that, by combining the particular components (a)-(d), in the particular amounts, recited in present claim 1, they developed a moisture-curing one pack urethane adhesive composition for bonding glass to painted steel without needing to use any primer.

The references relied on to reject the claims neither disclose nor suggest combining the particular components and the amounts of the components—as combined in the present claims—to prepare a moisture-curing one pack urethane adhesive composition, which effectively bonds glass to painted steel without using any primer.

In particularly, the cited references would never have led one skilled in the art to select

- the particular hexamethylene diisocyanate derivative (b),
- the particular isocyanate group-terminated urethane prepolymer (a),

Attorney Docket No. P68040US1  
Application No. 10/674,824

- the particular amount of the hexamethylene diisocyanate derivative (b), and
  - the particular amount of the isocyanate group-terminated urethane prepolymer (a)
- as combined in the present claims. The PTO formulates a composition matching that presently claimed only by using the present claims as a blueprint for searching and selecting from the prior art the particular components recited in the present claims.

With all due respect, if the PTO had only the cited references to consider (i.e., without having the subject application), it would be hard pressed to recreate the presently claimed invention, i.e., by picking and choosing from among components found in the different references in other combinations and by *optimization* of different component amounts found in the cited references. .

It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor.

*Northern Telecom, Inc. v. Datapoint Corporation*, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990), *cert. denied*, 498 U.S. 920 (1990) (emphasis added). Particularly with respect to the component amounts, the PTO does not explain how component amounts that are *unknown* to the skilled artisan (i.e., those recited in the present claims) are arrived at by the skilled artisan *optimizing* different component amounts found in the cited references. In this respect, applicants incorporate herein by reference their remarks, including the controlling precedent cited, presented in the response paper filed September 27, 2005.

Concerning the comments in the statement of rejection specifically addressing applicants' previously filed remarks (Office Action, page 4, item #6), the comments are not well taken. Contrary

Attorney Docket No. P68040US1  
Application No. 10/674,824

to these comments, applicants have not *ignored the facts*. In considering these facts, however, the PTO has ignored the law, i.e., that cited in applicants' previously filed remarks. The (allegedly ignored) "fact that, like the primary references, the secondary references are drawn to moisture curable polyurethane compositions; therefore, the compositions of the primary and secondary references are analogous" fails to satisfy the *legal standards for establishing the necessary prior art motivation* that would have created in the mind of one skilled in the art the "desire" to select the particular components found in the present claims from among the separate disclosures of these cited references.

The mere fact that it is possible to find two isolated disclosures which might be combined in such a way as to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination.

*In re Bergel*, 130 USPQ 206, 208 (CCPA 1961).

Additionally, according to the rejection (Office Action, page 4), "The position is maintained that it is *prima facie* obvious to utilize a known compound for its known function." This "position" is inapposite to the controlling precedent binding on the PTO. It is legally erroneous to reach a conclusion of obviousness under §103(a) solely on the basis that the claimed invention represents a "combination which only unites old elements with no change in their functions." *Pentec, Inc. v. Graphic Controls Corp.*, 227 USPQ 766, 771 (Fed. Cir. 1985).

... it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention.

*Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988).

Attorney Docket No. P68040US1  
Application No. 10/674,824

It is insufficient that the prior art disclosed the components of the patented device, either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor.

*Northern Telecom, Inc. v. Datapoint Corporation*, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990), *cert. denied*, 498 U.S. 920 (1990).

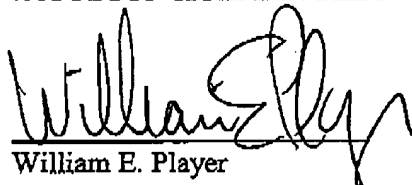
The PTO cannot ignore precedent by which it is bound in performing an analysis under §103(a). As explained, above, the instant finding of obviousness cannot be maintained in the face of precedent binding on the PTO.

Favorable action is requested.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By

  
William E. Player  
Reg. No. 31,409

400 Seventh Street, NW  
The Jenifer Building  
Washington, D.C. 20004  
Tel. (202) 638-6666  
Fax (202) 393-5350  
Date: March 8, 2006  
WEP/jhr

R:\Home\rdhomas\wep\2006\March\P68040US1 revised amdr (final).wpd